

Appl. No. 09/866,823  
Amendment and/or Reply  
To Office Action Dated  
February 17, 2006

## **2. REMARKS / DISCUSSION OF ISSUES**

Claims 1-20 are pending in the application. Claims 1, 9 and 17 are in independent form.

Unless indicated otherwise, claims are amended for non-statutory reasons: to correct one or more informalities, remove figure label number(s), and/or to replace European-style claim phraseology with American-style claim language.

### **I. Claim Objections**

Claim 17 was objected to for failing the state the system or method of the claimed features. Applicants respectfully disagree. Claim 17 features, inter alia, "For use in a communication network coupled to a plurality of video playback devices, a server..." Thus, a communication network coupled to a plurality of VDPs is claimed. It is respectfully submitted that one skilled in the art would readily appreciate the subject matter to which the claim is drawn.

### **II. Rejections under 35 U.S.C. § 102(e)**

1. Claims 17 and 18 were rejected under 35 U.S.C. § 102(e) as being unpatentable in view of *Susskind* (US 2001/0046366 A1).

2. Claims 1 and 9 were rejected under 35 U.S.C. § 102(e) as being unpatentable in view of *Utsunomiya, et al.* (US 2002/0066113 A1)

For at least the reasons set forth herein, it is respectfully submitted that these rejections are improper and should be withdrawn.

A proper rejection for anticipation "...requires, as the first step in the inquiry, that all the elements of the claimed invention be described in a single reference." *In re Spada* 15 USPQ2d 1655, 1657 (1990). A necessary corollary to the test of

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anticipation is that "...the absence from the reference of any claimed element negates anticipation." *Kloster-Speedsteel AB v. Crucible, Inc.* 230 USPQ 81, 86 (CAFC 1986).

**1. Susskind does not disclose the disk status indicator as claimed**

Claim 17 is drawn to a server comprising a memory for storing a plurality of data files related to a plurality of video playback devices. Each of the plurality of data files comprises a disk status indicator indicating an amount of free space available on a disk drive in a selected one of said video playback devices.

In an embodiment described in connection with Fig. 4A, each VDP data file 401-403 includes a disk statistics table that indicates the amount of space that is used and the amount of space that is free for recording programs. Thus, within the resource sharing server 130, each of the VDP data files 401-403 store disk drive space available.

By contrast, the portion of *Susskind* relied upon in the Office Action (pgh. [0035], lines 16-17) describes a web access device that is adapted to run an HTML web browser pointed to the URL of the host 23. The HTML pages provide all the interface components required to operate a video recording device 20. The essential functions of the device 20 are presented in HTML pages include minutes of storage available. This function is supplied by the internet remote control host server 24.

However, there is no description of a server having memory and including a plurality of data files, and that each data file indicates an amount of free space available on a disk drive. In fact, it is not clear from the noted portion of *Susskind* how the minutes of storage available for the device 20 are maintained, or that this relates to a disc drive as opposed to another type of permanent memory device. Therefore, it is respectfully submitted that because at least one element of claim 17 is not disclosed in the portion of the reference relied upon by the Examiner, a prima facie case of anticipation has not been established.

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For at least the reasons set forth above, it is respectfully submitted that the rejection of claim 17 is improper and should be withdrawn. Moreover, by similar reasoning, it is respectfully submitted that the rejection of claims 18-20 which depend immediately or ultimately from claim 17 is also improper and should be withdrawn.

**2. The rejection in view of *Utsunomiya, et al.* does not satisfy the requirements of MPEP § 706**

Claim 1 is drawn to a video playback device including a first and a second controller. The second controller is capable of determining if sufficient space is available on said disk storage device to store a first television program. Claim 9 is drawn to a method and includes a similar feature.

Applicants respectfully submit that a prima facie case of anticipation has not been made.

The rejection recites that *Utsunomiya, et al.* discloses "...a second controller capable of determining if sufficient space is available on said disk storage device to store said first television program (figure 2)..." A review of Fig. 2 does not reveal a second controller, but rather a sequence diagram. The description related to Fig. 2 discloses that the recorder/player 3 monitors the available capacity of disk 18 (shown in Fig. 3). Thus, it appears that the VCR 3 monitors capacity of a compact disc 18.

The above notwithstanding, the Office Action provides no more basis for the rejection than an allusion to a drawing in the applied reference. A basic goal of examination as set forth in MPEP § 706 is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. Applicants respectfully submit that a rejection has not been clearly articulated.

Respectfully, Applicants have paid the appropriate claim fees for this application. Applicants are entitled to a full and complete examination of each and every pending claim, including all features recited therein. If the Examiner cannot cite prior art taken alone or in combination which would have produced the linking

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unit, parametric encoder and method of claims 1 and 9, then Applicants respectfully submit that they are entitled to an allowance of their claims as a matter of law. Accordingly, the Examiner is respectfully requested to cite something in the prior art disclosing the device including all of the features recited in the various claims 1 and 9 or else allow Applicants' claims.

For at least the reason set forth above, it is respectfully submitted that the rejection of claims 1 and 9 are improper and should be withdrawn. Moreover, by similar reasoning, it is respectfully submitted that the rejection of the claims, which depend immediately or ultimately from claims 1 and 9 are also improper and should be withdrawn.

### **III. Rejection under 35 U.S.C. § 103(a)**

Claims 2-8, 10-16 and 19-20 were rejected under 35 U.S.C. § 103(a) in view of *Utsunomiya, et al.*, Susskind and secondary references and tertiary references noted in the Office Action. While in no way conceding the propriety of the rejection, Applicants respectfully submit that because these claims depend immediately or ultimately for claims 1, 9 or 17, the rejection of these dependent claims is improper and should be withdrawn.

### **IV. Conclusion**

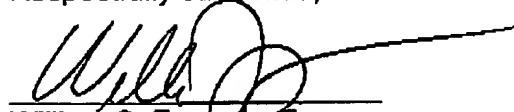
In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account

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Number 50-0238 for any additional fees, including, but not limited to, the fees under  
37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

Respectfully submitted,



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